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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/643,256

08/18/2003

Stephen Paul Zadesky

APL1P284/P3111

4668

67673 7590 03/23/2007

APPLE c/o MOFO NOVA  
1650 TYSONS BLVD.  
SUITE 300  
MCLEAN, VA 22102

EXAMINER

NGUYEN, JIMMY H

ART UNIT

PAPER NUMBER

2629

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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3 MONTHS

03/23/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

**Office Action Summary**

Application No.

10/643,256

Applicant(s)

ZADESKY ET AL.

Examiner

Jimmy H. Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 31 January 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-31 and 46-66 is/are pending in the application.
- 4a) Of the above claim(s) 1-31 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 46-66 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. This Office Action is made in response to applicant's amendment filed on 01/31/2007.

Claims 1-31 and 46-66 are currently pending in the application. Claims 1-31 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected Group I.

Claims 46-66 are considered as follows:

#### ***Notice To Applicants***

2. This application contains claims 1-31 drawn to an invention nonelected with traverse in Paper filed on 06/16/2006. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

3. Further, since Applicants have filed on 11/06/2006 a divisional application having a serial number "11/592679" and including claims 1-31, which are identical to claims 1-31 of this application, Examiner suggests the Applicants to cancel claim 1-31 of this application, in order to avoid the rejection under 35 USC 101 to this application and the application "11/592679".

#### ***Claim Objections***

4. Claim 52 is objected to under 37 CFR 1.75(a) because although this claim meets the requirement 112/2d, i.e., the metes and bounds are determinable, however, -- a selection for -- should be inserted immediately after "comprises" in line 1, in order to clarify the claimed invention.

#### ***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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6. Claims 48-49 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 48 recites the limitation "**the rotational input device**" in line 3. There is insufficient antecedent basis for this limitation in the claim.

As to claim 49, since this claim depends upon claim 48, this claim is therefore rejected for the same reason set forth in claim 48 above.

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 46-49, 52-57, 60-62, 32-45 are rejected under 35 U.S.C. 102(b) as being anticipated by Molne (US 6,243,080 B1, cited in IDS filed on 09/26/2006).

As to claims 46-49, 52, 54-57, 61, 62, and 66, Molne discloses a portable media player (a wireless communication device 10, see Fig. 1, col. 7, lines 30-34) comprising a **housing** (see Fig. 1) including a **frame** (a casing 17, see Fig. 1 or 2); and a **touchpad/rotational input device** (a touch sensitive panel 30, see Figs. 2-5) disposed within the housing (see Figs. 1 and 3) and capable of a gimbal action relative to the housing, wherein the gimbal action of the user input apparatus enables a user of the portable media player to make media selections and enables the touch panel to pivot relative to the frame(17) and the housing (see Figs. 2-5 and the corresponding description, specifically col. 6, lines 31-45). Molne further teaches a touchpad

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(30) configured to receive a rotational input from a user's finger by virtue of the description at col. 3, lines 16-32.

Further regarding to the claimed limitations, **“the touchpad/rotational input device comprises a plurality of spatially distinct zones, each of the zones having a corresponding indicator for generating a distinct user input signal when the touchpad/rotational input device is depressed in the region of the zone”**, Molne discloses at col. 6, lines 31-46 that the touch-sensitive panel 30 (i.e., the claimed rigid user interface platform) including a portion corresponding to the keypad, so that each key of the keypad corresponding to an input zone having a corresponding one of the movements indicator for generating a distinct user input signal when the touch-sensitive panel 30 (i.e., the claimed rigid user interface platform) is moved in the region of the input zone. Based on the mentioned passage, Molne implicitly discloses the above underlined limitations.

Accordingly, all the limitations of these claims are read in the Molne reference.

As to claims 53, 60, and 65, Molne discloses an input surface of the touchpad/rotational input device substantially co-planer with an external surface of the housing (see Fig. 3).

### ***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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10. Claims 50, 51, 58, 59, 63, and 64 are rejected under 35 U.S.C. 103(a) as being unpatentable over Molne as applied to claims 46, 54, and 61, and further in view of Trent, JR. et al. (US 2004/0252109 A1), hereinafter Trent.

As to these claims, Molne as discussed in the rejection of independent claims 46, 54, and 61 above, Molne discloses all the claimed limitations of these claims except that Molne does not teach that the touchpad is based on a polar coordinate system as presently recited in claims 50, 58 and 63 and the touchpad is circular as presently recited in claims 51, 59, and 64.

However, Trent discloses a circular touchpad (a touch sensor, e.g., see Fig. 3, 37, or 38) based on a polar coordinate system (see paragraph [0090]). Trent further teaches that the benefit of using the circular touchpad (the touch sensor) based on the polar coordinate system is to provide a user a number of functions associated with a particular application (see Fig. 38; paragraph [0137]). Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the invention was made to replace the Molne rectangular touchpad with a circular touchpad based on a polar coordinate system, in view of the teaching in the Trent reference, because this would provide a user a number of functions associated with a particular application of the Molne device, as taught by the Trent reference (see Fig. 38; paragraph [0137]).

11. Claims 50-52, 58, 59, 63, and 64 are rejected under 35 U.S.C. 103(a) as being unpatentable over Molne and further in view of Matzke et al. (US 4,736,191), hereinafter Matzke.

As to these claims, Molne as discussed in the rejection of independent claims 46, 54, and 61 above, Molne discloses all the claimed limitations of these claims except that Molne does not

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teach that the touchpad is based on a polar coordinate system as presently recited in claims 50, 58 and 63 and the touchpad is circular as presently recited in claims 51, 59, and 64.

However, Matzke discloses a circular touchpad (a touch pad 14, see Fig. 1) based on a polar coordinate system (see col. 8, lines 22-27). Matzke further teaches that the benefit of using the circular touchpad (the touch sensor) based on the polar coordinate system is to provide a user capable of commanding movement of the cursor in essentially any angular direction rather than being limited to translation of the cursor in only certain angular directions (see col. 3, lines 26-31). Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the invention was made to replace the Molne rectangular touchpad with a circular touchpad based on a polar coordinate system, in view of the teaching in the Matzke reference, because this would provide a user capable of commanding movement of the cursor in essentially any angular direction rather than being limited to translation of the cursor in only certain angular directions, as taught by the Matzke reference (see col. 3, lines 26-31).

### ***Double Patenting***

12. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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13. Claims 46-66 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 6, 7, 11, and 16 of U.S. Patent No. 7,046,230 B2, hereinafter Patent230 in view of Molne.

Claims 1, 6, 7, 11 and 16 of Patent230 are directed to a portable media player comprising all limitations of the pending claims 46-66 except for the limitations, “ a touchpad/rotational input device capable of a gimbal action relative to the housing, wherein the gimbal action of the user input apparatus enables a user of the portable media player to make media selections and enables the touch panel to pivot relative to the frame and the housing; and the touchpad/rotational input device comprising a plurality of spatially distinct zones, each of the zones having a corresponding indicator for generating a distinct user input signal when the touchpad/rotational input device is depressed in the region of the zone”, as presently claimed. However, Molne expressly teaches the above underlined limitations, see the rejection to claims 46-49, 52, 54-57, 61, 62, and 66. Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the invention was made to modify the touchpad of the device of claims 1, 6, 7, 11 and 16 of Patent230, in view of the teaching in the Molne reference, because this would provide a user a touchpad with selector, thereby allowing the user to select and to normally operate the touchpad without removing the finger from the touchpad, as taught by Molne (see col. 2, lines 5-44).

#### ***Response to Arguments***

14. It is noted Applicants that the objections and rejections in the previous Office action dated 10/27/2006 have been rendered moot in light of cancellation to claims 32-45.

#### ***Conclusion***



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15. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

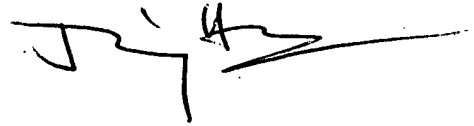
16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jimmy H. Nguyen whose telephone number is 571-272-7675. The examiner can normally be reached on Monday - Thursday, 8:00 a.m. - 5:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bipin Shalwala can be reached at 571-272-7681. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR

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system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'JH Nguyen', with a long horizontal line extending to the right.

JHN  
March 21, 2007

Jimmy H. Nguyen  
Primary Examiner  
Technology Division: 2629